



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/761,701

01/21/2004

C. Allen Brown

23060-RA

3358

30184

7590

04/26/2005

MYERS & KAPLAN, INTELLECTUAL PROPERTY LAW, L.L.C.
1899 POWERS FERRY ROAD
SUITE 310
ATLANTA, GA 30339

EXAMINER

COHEN, AMY R

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary	Application No. 10/761,701	Applicant(s) BROWN, C. ALLEN	
	Examiner Amy R. Cohen	Art Unit 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the circumference of 12 inches, 19 2/10 inches, and 24 inches must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14, 16-18, 20, 21, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley (U. S. Patent No. 2,495,974) in view of Canalle (U. S. Patent No. 6,571,487).

Claims 1-11, 17, 18: Kelley discloses an apparatus (Fig. 1) for measuring distances, said apparatus comprising: a wheel (3, 5) comprising incremental line markers for measuring distances (Figs. 5, 6, 8, 9); and a housing (1) that functions as a layout tool (Fig. 1) selected from a group consisting of a straight edge, a gauging block, a ruler, or a combination thereof (Col 1, lines 5-19).

Kelley discloses the apparatus wherein said wheel comprises a circumference, said circumference selected from a group consisting of a 12-inch circumference (Figs. 8 and 9), a 16-inch circumference, a nineteen and two-tenths-inch circumference, and a 24-inch circumference (Col 4, lines 5-21).

Kelley discloses the apparatus wherein said housing further functions as a gauging block (Col 1, lines 5-19), and wherein said housing further comprises a truncated flat front wall (13, Fig. 1), said front wall enabling said housing to rest against a wall surface (Fig. 1).

Kelley discloses the apparatus wherein said housing comprises a sidewall (11), said sidewall comprising measuring notches (45) for measuring linear distances (Fig. 1).

Art Unit: 2859

Kelley discloses the apparatus wherein said housing comprises a sidewall (9, 11, 34) comprising a length (45), said length selected from a group consisting of 1 ½ inches, 3 inches, 3 ½ inches, and 5 ½ inches (Fig. 2).

Kelley discloses the apparatus wherein said housing comprises a first sidewall adjacently disposed to a second side wall at an angle selected from a group consisting of 45 degrees and 90 degrees (Col 1, lines 5-45 and Col 3, lines 5-19).

Kelley does not disclose the apparatus comprising a squaring lip, wherein said squaring lip is disposed on said housing; wherein said squaring lip comprises a nail hole; wherein said squaring lip comprises a string groove.

Canalle discloses an apparatus (10) for measuring distances, said apparatus comprising: a housing (10) that functions as a layout tool, said layout tool selected from a group consisting of a straight edge, a gauging block, a ruler, or a combination thereof (Col 1, line 60-Col 2, line 56), and a squaring lip (26, 28, 30), wherein said squaring lip is disposed on said housing (Figs. 1-6); wherein said squaring lip comprises a nail hole (29, 88); wherein said squaring lip comprises a string groove (29, 88).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Kelley to include a squaring lip, as taught by Canalle, so that a user may accurately mark the centerlines of studs while framing (Canalle, Col 1, lines 50-59 and Col 2, lines 15-27).

Claims 7-11, 20, 21, 23: Kelley discloses an apparatus (Fig. 1) for measuring distances, said apparatus comprising: a wheel (3, 5) comprising incremental line markers for measuring distances (Figs. 5, 6, 8, 9); and a housing (1) comprising edges dimensioned and configured to

Art Unit: 2859

correspond to the sizes and angles most often encountered during framing (Fig. 1, Col 1, lines 5-45 and Col 3, lines 5-19).

Kelley discloses the apparatus wherein said wheel comprises a circumference, said circumference selected from a group consisting of a 12-inch circumference (Figs. 8 and 9), a 16-inch circumference, a nineteen and two-tenths-inch circumference, and a 24-inch circumference (Col 4, lines 5-21).

Kelley discloses the apparatus wherein said housing comprises a sidewall (11), said sidewall comprising measuring notches (45) for measuring linear distances (Fig. 1).

Kelley discloses the apparatus wherein said housing comprises a sidewall (9, 11, 34) comprising a length (45), said length selected from a group consisting of 1 ½ inches, 3 inches, 3 ½ inches, and 5 ½ inches (Fig. 2).

Kelley discloses the apparatus wherein said housing comprises a first sidewall adjacently disposed to a second side wall at an angle selected from a group consisting of 45 degrees and 90 degrees (Col 1, lines 5-45 and Col 3, lines 5-19).

Kelley discloses the apparatus wherein said housing further functions as a gauging block (Col 1, lines 5-19), and wherein said housing further comprises a truncated flat front wall (13, Fig. 1), said front wall enabling said housing to rest against a wall surface (Fig. 1).

Kelley does not disclose the apparatus comprising a squaring lip, wherein said squaring lip is disposed on said housing; wherein said squaring lip comprises a nail hole; wherein said squaring lip comprises a string groove.

Canalle discloses an apparatus (10) for measuring distances, said apparatus comprising: a housing (10) that functions as a layout tool, said layout tool selected from a group consisting of a

Art Unit: 2859

straight edge, a gauging block, a ruler, or a combination thereof (Col 1, line 60-Col 2, line 56), and a squaring lip (26, 28, 30), wherein said squaring lip is disposed on said housing (Figs. 1-6); wherein said squaring lip comprises a nail hole (29, 88); wherein said squaring lip comprises a string groove (29, 88).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Kelley to include a squaring lip, as taught by Canalle, so that a user may accurately mark the centerlines of studs while framing (Canalle, Col 1, lines 50-59 and Col 2, lines 15-27).

Claims 12-14, 16: Kelley discloses a method for measuring distances, said method comprising the steps of: obtaining an apparatus (Fig. 1) for measuring distances, said apparatus comprising a wheel (3, 5) comprising incremental line markers for measuring distances (Figs. 5, 6, 8, 9), and a housing that functions as a straight edge (Figs. 1, 5, 6, 8, 9, Col 1, lines 5-45 and Col 3, lines 5-19).

Kelley discloses the method comprising the step of placing said wheel on a starting point on a surface requiring measurement, and rolling said wheel over the surface (Col 1, line 42-Col 2, line 16 and Col 4, lines 52-72).

Kelley discloses the method comprising the step of determining the distance traveled by said wheel from the starting point, wherein the distance is ascertained by said incremental line markers on said wheel (Col 1, line 42-Col 2, line 16, and Col 4, line 52-Col 5, line 19).

Kelley discloses the method comprising the step of utilizing said housing to measure the sizes and angles most often encountered during framing (Col 1, line 42-Col 2, line 16, and Col 4, line 52-Col 5, line 19).

Art Unit: 2859

Kelley does not disclose the method comprising a squaring lip.

Canalle discloses a method for measuring distances, said method comprising the steps of: obtaining an apparatus (10) for measuring distances, said apparatus comprising a housing (10) that functions as a straight edge (Col 1, line 60-Col 2, line 56) and a squaring lip (26, 28, 30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Kelley to include a squaring lip, as taught by Canalle, so that a user may accurately mark the centerlines of studs while framing (Canalle, Col 1, lines 50-59 and Col 2, lines 15-27).

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley and Canalle as applied to claims 1-14, 16-18, 20, 21, 23 above, and further in view of Pearson (U. S. Patent No. 3,046,884).

Kelley and Canalle disclose the apparatus and method as described above in paragraph 3 and wherein interval distances are indicated by an audible sound and by said incremental line markers on said wheel (Kelley, Col 1, line 42-Col 2, line 16 and Col 4, line 52-Col 5, line 19).

Kelley and Canalle do not disclose the apparatus and method specifically comprising the step of marking the surface at selected intervals indicated by said incremental line markers on said wheel.

Pearson discloses an apparatus and method specifically comprising the step of marking the surface at selected intervals indicated by said incremental line markers on said wheel (Figs. 1 and 4 and Col 1, lines 7-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus and method of Kelley and Canalle to include marking

Art Unit: 2859

distances at the selected intervals, so that a user would be able to easily recall the number of times the incremental line markers on the wheel made a revolution, in order to more easily indicate the total distance traveled.

5. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley and Canalle as applied to claims 1-14, 16-18, 20, 21, 23 above, and further in view of Presley (U. S. Patent No. 3,163,941).

Kelley and Canalle disclose the apparatus as described above in paragraph 3, and wherein said housing comprises an enlarged cutout, wherein said enlarged cutout permits a large portion of said wheel to be exposed for contacting a workpiece (Kelley, Figs. 1, 4, and 10, the entire bottom of the housing comprises an enlarged cutout, permitting a larger portion of the wheel to be exposed for contacting the workpiece).

Kelley and Canalle do not disclose the apparatus wherein said enlarged cutout provides an additional viewing area for viewing said incremental line markers of said wheel.

Presley discloses an apparatus for measuring distances, said apparatus comprising: a wheel (22) comprising incremental line markers (26) for measuring distances and a housing (10); wherein said housing comprises an enlarged cutout (bottom of housing which ends at sides 18a, 18b is the enlarged cutout, Figs. 1-3, 6), wherein said enlarged cutout permits a large portion of said wheel to be exposed for contacting a workpiece (Fig. 6); and wherein said enlarged cutout provides an additional viewing area for viewing said incremental line markers of said wheel (Fig. 6, Col 2, line 70-Col 3, line 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Kelley and Canalle to lower the wheels within the housing in

Art Unit: 2859

order to provide additional viewing of the incremental line markers, as taught by Presley, so that a user could accurately align the apparatus with a zero mark for measuring along a surface (Presley, Col 4, lines 20-55).

Response to Arguments

6. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

7. Regarding Applicant's argument that Kelley does not teach a housing comprising "a truncated flat front wall for allowing said housing to rest against a wall surface," Examiner disagrees. Kelley teaches the truncated flat front wall 13 (Kelley, Fig. 1). The claim language "enabling said housing to rest against a wall" is considered intended use of the device and therefore, not given patentable weight in the apparatus claims.

8. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., measuring the inner circumference of a circular loop, plumb line and roof pitch line markings) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. Regarding Applicant's arguments that Applicant's invention "possesses a single narrow measuring wheel, whereas the tools in Kelley and Pearson include multiple wheel that are much wider," Examiner is not persuaded. Applicant claims an apparatus "comprising a wheel." Since "comprising" is considered open claim language, an apparatus containing one or more wheels

Art Unit: 2859

will satisfy Applicant's claim language. Moreover, Applicant does not claim the dimensions of width for the wheel.

10. In response to applicant's argument that the apparatus is specifically designed to act as a framing template, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2859

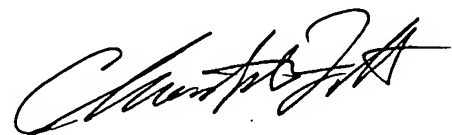
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R. Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARC
April 25, 2005



Christopher Fulton
Primary Examiner
Tech Center 2800